REMARKS

Claims 1 to 28 and 31 to 33 are pending, of which Claims 1, 11, 16 and 24 are independent. Claims 7 and 33 are amended. Reconsideration and further examination are respectfully requested.

By way of an introduction and a non-limiting example, one or more embodiments have application in an advertising industry that serves ads via a network to a user computer, and desires to monitor the effectiveness of served ads. Any of a number of measures might be used in monitoring an ad's effectiveness, including capturing the number of times the ad is viewed by a user (often referred to as a "page view"), the number of times a user activates a link in the ad to the advertiser's web page (often referred to as a "click-through"), and the number of times a user makes a purchase after activating a link in the ad (often referred to as an "acquisition").

In accordance with a conventional approach described in the present application, an "ad-serving entity" receives advertising content from advertisers or agencies, and uses a staff of programmers to incorporate received ad content into ad code before the ad content is served to a user computer. This process must be repeated any time the ad content and/or ad code changes. Such work is labor intensive and results in both decreased profits for the entities serving the ads and, to the extent the cost is not completely absorbed by the entity serving the ad, increased advertising costs to the advertiser and/or agency.

In accordance with aspects of the claims, by way of non-limiting example, an integrated ad file, which is served to a computer to provide the ad, is created by combining an ad input file, which identifies ad content, with a conduit file, which comprises computer code to track the ad. With this arrangement, an advertiser may provide the content to any number of different ad-serving entities without concerning itself with the ad tracking methodologies that are to be used with the content. Similarly, a tracking methodology can be selected and implemented independent of the ad content. On one hand, advertisers may modify the ad content without implicating changes to the tracking code, and on the other hand, modifications can be made to the tracking methodology and code without implicating changes to the ad content.

By way of a non-limiting example and with reference to Figure 5 of the present application, in accordance with one or more embodiments, an ad input file, e.g., ad input file 504, is combined with a conduit file, e.g., conduit file 506, using a merge tool 502 to

automatically create an integrated ad file prior to serving the integrated ad file from a computer. The merge tool 502 automatically creates integrated ad file 204 using the ad input file 504 and the conduit file 506, wherein the ad input file 204 identifies the content of the ad and the conduit file comprises computer code to identify tracking data for the ad. Reference is also respectfully made to Figures 6 to 9 of the present application. Figure 6 illustrates a portion of an exemplary ad input file 502, and Figure 8 provides an example of an integrated ad file 204 portion that includes the contents of the exemplary ad input file 502. As is described in paragraph [0028] of the published application, the ad input file includes the contents of the ad. Figure 7 illustrates a portion of an exemplary conduit file 506, and Figure 9 illustrates a portion of the integrated ad file 204 portion that includes the exemplary conduit file 506.

Claims 1, 4, 7 to 12, 24 to 27 and 31 to 33 were rejected under 35 U.S.C. § 102(b) as being anticipated by a document identified by the URL: http://demo.doubleclick.com/ generators /docs/ designer-version.pdf, which is referred to as "DoubleClick", Claims 2, 3, 13, 14, 22, 23 and 28 are rejected under 35 U.S.C. § 103(a) over DoubleClick in view of Official Notice, and Claims 5, 6 and 15-21 are rejected under 35 U.S.C. § 103(a) over DoubleClick in view of Chun's *Macromedia Flash Advanced for Windows and Macintosh: Visual QuickPro Guide* (Chun). Reconsideration and withdrawal of the rejections are respectfully requested for at least the reasons set forth below.

With respect to Claims 2, 3, 13, 14, 22, 23 and 28, the Office Action takes Official Notice in rejecting these claims. The Examiner, at page 4 of the Office Action, fails to identify the elements of the claims that she considers to be missing from DoubleClick, fails to identify the facts for which she is taking Office Notice, and simply concludes, without providing any support, that:

> it would have been obvious to one of ordinary skill in the art at the time of the
> invention to known that the designer or programmers of DoubleClick would accept a
> new or modified information or content from the source and insert the same or
> different tracking information according to the goals of the campaign or the
> preference of the tracking server.

The Applicant respectfully requests that the Examiner identify, with specificity, what elements of claims 2, 3, 13, 14, 22, 23 and 28 are not disclosed by DoubleClick, identify, with

specificity, the facts that are being Officially Noticed, and provide the requisite support for the Officially Noticed facts, should the Examiner continue to rely on Official Notice.

In *In Re Chevenard*, 139 F.2d at 711, 60 USPQ at 239 (CCPA 1943), which is cited in the MPEP, something more than a total absence of some demand is sufficient, and that such a response would be more than sufficient to prompt the examiner to produce authority for her assertions in response. It is clear from MPEP § 2144.03 and the case law provided therein that Applicant's request/response is more than sufficient to establish that such support is required and that such support should be supplied, as requested by the Applicant. Furthermore and as is also made clear in MPEP § 2144.03, Official Notice is only appropriate in a limited number of circumstances and should only be taken where the facts asserted to be well-known or common knowledge are capable of instant and unquestionable demonstration as being well-known or common knowledge, which is not the case here.

Therefore, with respect to the Official Notice taken, the Applicant respectfully requests that the Examiner provide evidence that above-requested information, should the Examiner maintain the current rejection. Furthermore, it is respectfully submitted that the Officially Noticed facts fail to cure the deficiencies noted herein with respect to DoubleClick.

Turning to the grounds of rejection under § 102, claim 1 recites a method for providing an ad via a computer network. According to the method, an ad input file that identifies the content of an ad is combined, at a server, with a conduit file that is separate from the ad input file and that comprises computer code to identify tracking data for the ad, the combining of the ad input file and separate conduit file uses a merge tool that automatically creates a single integrated ad file from the ad input file and separate conduit file prior to serving the single integrated ad file from a server. The single integrated ad file has a single file extension, contains both the ad input file and the conduit file and is served from the server to provide the ad.

In response to the Applicant's previous remarks, the Examiner, at page 6 of the Office Action, repeats portions of the Applicant's previous remarks, and then states that the:

> Examiner could not understand how applicant came to such a conclusion.
> "DoubleClick does not a person referred to a designer in must edit the ad Flash
> file to include a 'clicking' variable."

To the extent that the Examiner's response is understood, at the bottom of page 3 of DoubleClick, DoubleClick states that *this document describes to the FLASH designer how to make the FLASH file compliant to the new tracking method* (emphasis added). As just some of the examples of DoubleClick's description for the FLASH designer on how to make the FLASH file compliant with the new tracking method, at page 2, DoubleClick identifies certain parameters, i.e., that *clickTag is used in the URL*, *the URL box is set for an expression*, and *the target window is set appropriately (generally _blank is the best choice)*; and DoubleClick instructs that the designer should *make sure that [these] parameters are set when the ad clicks over to a site*. DoubleClick states that *the accompanying figures show examples [of] what the Flash 4 and Flash 5 interface should look like when all the parameters are set appropriately*. As some further examples of DoubleClick's description for the FLASH designer on how to make the FLASH file compliant with the new tracking method, at page 3 of DoubleClick, just below Figure 2 (which shows a Flash 5 interface entitled "Object Actions"), DoubleClick describes that *the text that is entered into the URL box is an expression …. In order for this method to function correctly, you must indicate that the text is an expression*. The same paragraph of DoubleClick continues and describes that:

> *[i]n Flash 4, the button to the right of the URL should have an equal sign. It should not have the letters abc. (See Fig. 1.) In Flash 5, the expression check box should be checked. (See Fig. 2). Note that there are two buttons or check boxes. One is for the URL and one is for the target window. Make sure that the button or check box for the URL is set correctly…. We usually recommend to set the target to _blank…. If you are not passing variables to the advertiser's site, set the Variables drop down box to 'Don't send'. To pass variables with DoubleClick ad servers, choose 'Send using GET'.*
> (Emphasis in original removed.)

DoubleClick expressly provides instructions for someone, perhaps the designer, to make changes to the FLASH file, e.g., with reference to Figure 2 at page 3, that text is entered into the URL box shown in Figure 2, the check box shown in Figure 2 must be checked, and that the target window should be set to *_blank*, to make the FLASH file compliant with DoubleClick's method. DoubleClick shows interface screens and describes what should be entered in fields shown in the interface screen. The only reasonable interpretation based on the description

provided by DoubleClick is that the designer edits <u>the FLASH file</u> makes the changes to <u>the</u> <u>FLASH file</u> to make <u>the FLASH file</u> compliant with DoubleClick.

As such, DoubleClick approach appears to be much like the approach described in the background discussion of the present application, i.e., a labor intensive process whereby someone must edit the ad file to include tracking code, i.e., the "clickTag" variable in DoubleClick's case. DoubleClick, therefore, must suffer from many of the same drawbacks discussed in the background discussion of the present application, i.e., each time the ad or the tracking code is modified, the ad Flash file must be updated; e.g., DoubleClick discloses that a person must edit an ad Flash file any time the DART system requires the ad Flash file to be changed to make it compliant with the DART system. By way of a non-limiting example, the claimed merge tool that automatically creates an integrated ad file from an ad input file and a conduit file avoids the need for a designer to makes the edits to an ad Flash file described in DoubleClick.

Turning to the grounds for rejecting the claims, in particular claim 1, based on DoubleClick, the Office Action states, at page 2, that (italics in original):

> "[r]egarding claim 1, DoubleClick teach *combining at a server* an ad input file (Flash file, FLASH banner ads, FLASH movie) with a conduit file *(clickButton,[1] on (release) (getURL (clickTag, "blank) (see fig.1 and fig.2), separate from the ad input file,* automatically create a single integrated ad file having a single file extension (swf file) *from the ad input file and the separate conduit file using a merge tool* (ActionScript used to combine the clicktag together with the movie) prior to the server serving the integrated ad file; wherein the conduit file comprises of computer code (ClickTag) for tracking data for the ad, and serving the integrated ad file from a computer to provide the ad (see pp 1-3)."

There is no sound basis for interpreting DoubleClick as disclosing both an ad input file and a separate conduit file that is separate from the ad input file, as is required in claim 1. DoubleClick describes one file, i.e., <u>the FLASH file</u>, and describes how to make <u>the FLASH file</u> compliant with its method; DoubleClick does not disclose or suggest both *an ad input file* and a

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[1] A review of the DoubleClick reference fails to yield any mention of *clickButton*; the Examiner is respectfully requested to provide clarification as to what a *clickButton* is and where it is found in DoubleClick should the Examiner maintain her rejection.

separate conduit file, as is recited in Claim 1. According to DoubleClick, clickTag is a parameter; a parameter is not a file, let alone a conduit file. Similarly, the *On (Release) (getURL (clickTag, "_blank);* is nothing more than text displayed in an interface screen to verify that the changes to the FLASH file were appropriately made in accordance with the instructions to the designer on how to make the FLASH file compliant with DoubleClick. DoubleClick can only reasonably be interpreted to describe one file, i.e., the FLASH file. This is in stark contrast to the claimed *ad input file* and claimed *separate conduit file*, recited in claim 1. Nothing in the examples suggested by the Examiner as allegedly disclosing the claimed conduit file can reasonably be interpreted to disclose or even to suggest the claimed conduit file, which is separate from the claimed ad input file.

Furthermore and while any of the above reasons should be more than sufficient basis to withdraw the § 102 rejection, DoubleClick further fails to disclose the claimed merge tool that automatically creates a single integrated ad file from the claimed ad input file and the claimed separate conduit file. While DoubleClick mentions that *ActionScript is used to combine the clickTag together with the movie*, DoubleClick is silent with respect to how this is performed, and nothing in DoubleClick can reasonably be interpreted as DoubleClick disclosing the claimed merge tool that automatically creates a single integrated ad file from the claimed ad input file and the claimed separate conduit file. Furthermore, according to DoubleClick, the "clickTag" is a parameter, not a file. A clickTag that is disclose as being a parameter cannot reasonably be interpreted to disclose a conduit file that is separate from an ad input file. DoubleClick mentions only one file, i.e., the FLASH file; DoubleClick does not mention an ad input file, a separate conduit file, and/or an integrated ad input file that is automatically created using the claimed merge tool to combine the ad input file and the separate conduit file.

Furthermore and while any one of the above reasons should be more than sufficient basis to withdraw the § 102 rejection, DoubleClick cannot reasonably be interpreted to disclose computer code contained in a conduit file that is separate from an ad input file, the computer code contained in the separate conduit file to identify tracking data for an ad; nothing in DoubleClick can reasonably be interpreted to disclose the claimed computer code, which is contained in a conduit file that is combined with an ad input file by a merge tool that automatically creates a single integrated ad file containing the contents of the conduit file (the

computer code to identify tracking data for the ad) and the contents of an ad input file (the

content of the ad), as recited in Claim 1. At page 2, DoubleClick describes that Figures 1 and 2

show examples of what the Flash 4 or Flash 5 interface should look like for the FLASH file, per

the instructions to the designer on how to make the FLASH file compliant with DoubleClick.   In

accordance with the instructions provided by DoubleClick to the designer on how to make the

FLASH file compliant with DoubleClick and with reference to Figure 1 of DoubleClick, for

example, the FLASH file must include the parameter/variable "clickTag" set, the button to the

right of the URL box must be set to "=" to indicate that the ActionScript is to evaluate

"clickTag" as an "expression" and "_blank" must be entered in the window box, etc. As is

described at page 3 of DoubleClick:

> The text that is entered into the URL box is an expression. When the movie
>
> plays, the expression will be evaluated and replaced with the click tracking string
>
> and the destination URL from the HTML sniffer code, in the DART system. In
>
> order for this method to function correctly, you must indicate that the text is an
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> expression. In Flash 4, the button to the right of the URL should have an equal
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> sign. It should not have the letters abc. (See Fig. 1.) In Flash 5, the expression
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> check box should be checked. (See Fig. 2). Note that there are two buttons or
>
> check boxes. One is for the URL and one is for the target window. Make sure
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> that the button or check box for the URL is set correctly.

DoubleClick only discloses one file, the FLASH file, and describes for the FLASH

designer how to make the FLASH file compliant. In contrast, the claim language recites both an

ad input file and a conduit file that is separate from the ad input file, and further recites

combining the claimed ad input file and the claimed conduit file that is separate from the claimed

ad input file using a merge tool that automatically creates the claimed single integrated ad file

from the two separate files.

DoubleClick does not disclose or suggest the claimed ad input file that identifies the

content of an ad and a conduit file that is separate from the ad input file and that comprises

computer code to identify tracking data for the ad, combining the ad input file and the separate

conduit file using a merge tool that automatically creates a single integrated ad file from the ad

input file and the separate conduit file. Additionally, DoubleClick fails to disclose or suggest

combining two separate files, an ad input file and a conduit file, to create a single integrated ad file prior to the server serving the single integrated ad file. DoubleClick fails to disclose or suggest an ad input file that identifies content of an ad and a conduit file which is separate from the ad input file and comprises computer code to identify tracking data for the ad; DoubleClick further fails to disclose the claimed combining of the ad input file and the separate conduit file using a merge tool to automatically create a single integrated ad file from the ad input file contents and the conduit file, the claimed single integrated ad file being automatically created prior to a server serving the single integrated ad file and has a single file extension.

Since DoubleClick is missing multiple elements of claim 1, DoubleClick cannot form the basis of a proper § 102 rejection of claim 1. Additionally and since DoubleClick is missing multiple elements of claim 1, DoubleClick cannot form the basis of a proper § 103 rejection of claim 1, and no such rejection is raised in the Office Action. For at least the same reasons, DoubleClick cannot form the basis of a proper § 102 rejection, and that DoubleClick alone cannot form the basis of a proper § 103 rejection, of the claims that depend from claim 1.

With regard to independent claims 11, 16 and 24, the Examiner rejects the claims under § 102 over DoubleClick. The discussion of DoubleClick provided above in connection with claim 1 is applicable to claims 11, 16 and 24, and the claims that depend from claims 11, 16 and 24. Furthermore, the Examiner admits at page 5 of the Office Action that DoubleClick fails to disclose a placeholder. In view of the concession made by the Examiner, DoubleClick cannot reasonably be interpreted to disclose the placeholder(s) recited in claims 11, 16 and 24, or any of the dependent claims.

As is recited in claim 11, for example, the claimed placeholder is in the claimed first file, and the claimed second file is electronically inserted into the placeholder in the first file to create the single integrated ad file having a single file extension, the single integrated ad file including an ad and computer code to identify tracking data for the ad. According to claim 16, as yet another example, first and second placeholders are in the claimed third file, the claimed first file is electronically inserted into the first placeholder in the third file, and the claimed second file is electronically inserted into the second placeholder in the third file to create the single integrated ad file having a single file extension, the single integrated ad file including an ad and the computer code to identify tracking data for the ad.

At page 3 of the Office Action, the Examiner mentions the frame that is described in
DoubleClick. DoubleClick describes a frame in a paragraph found at page 3, which is
reproduced herein below, as follows:

> [m]ost richmedia advertising is served through a different frame or through
> javascript. Frames or javascript allow a site to rotate ads. Because frames are
> sometimes used, the target window for the click through URL must be set
> appropriately. If the target window is set incorrectly, the advertiser's site will not
> appear in the right location. We usually recommend to set the target to _blank.

DoubleClick makes clear that its frame is used to serve an ad and allow a site to rotate
through ads that it serves, which is nothing like the claimed placeholder in the claimed first file,
at which a second file is electronically inserted into the first file. At least based on the
concessions made in the Office Action, DoubleClick fails to disclose the claimed placeholder,
and DoubleClick cannot reasonably be interpreted to disclose the claimed second file being
electronically inserted into the placeholder in the first file to create the single integrated ad file
having a single file extension, the single integrated ad file including an ad and computer code to
identify tracking data for the ad. If further follows, at least based on the concessions made in the
Office Action, that DoubleClick cannot reasonably be interpreted to disclose the claimed first
and second placeholders in the claimed third file, and/or the claimed first file being electronically
inserted into the first placeholder in the third file, and the claimed second file being
electronically inserted into the second placeholder in the third file to create the single integrated
ad file having a single file extension, the single integrated ad file including an ad and the
computer code to identify tracking data for the ad, as recited in claim 16. In view of the
concessions made by the Examiner and the discussion of DoubleClick provided herein, it is
respectfully submitted that DoubleClick fails to disclose the claimed placeholder and the claimed
first and second placeholders. Thus, in light of the concessions made in the Office Action and
the discussion provided herein, it is respectfully submitted that DoubleClick fails to disclose each
and every one of the elements of claims 11, 16 and 24 and the claims that depend from claims
11, 16 and 24.

For at least the foregoing reasons, independent claims 1, 11, 16 and 24, and the claims
that depend from these claims, are believed to be patentable over DoubleClick.

With respect to Claims 7 to 10, the Office Action alleges that page 3 of DoubleClick teaches the elements recited in these claims. Claim 7 recites, *inter alia*, that the ad includes one or more actions for linking to one or more web pages and wherein the ad input file specifies one or more buttons, each of which has an exit code, and the serving the single integrated ad file includes html code loading the single integrated ad file and specifying the URLs for the web pages; claim 8 recites, *inter alia*, that serving the single integrated ad file includes html code loading the single integrated ad file, the html code including a variable and wherein the conduit file includes code that determines whether the ad opens in a parent window or new window based on the variable; claim 9 recites, *inter alia*, serving the single integrated ad file includes html code loading a JavaScript file, the html code including a variable and wherein the JavaScript file includes code that determines whether the ad opens in a parent window or new window based on the variable; and claim 10 recites, *inter alia*, serving the single integrated ad file includes html code loading the single integrated ad file, the html code including a tracking identifier, the method further comprising tracking the ad using code in the conduit file and the tracking identifier. In view of the above discussion of DoubleClick, including page 3 of DoubleClick, it is respectfully submitted that DoubleClick fails to disclose or suggest at least the above-identified elements of Claims 7 to 10. The Applicant renews the request for the Examiner to identify the <u>particular portions and precise elements</u> of DoubleClick that the Examiner considers teaches each and every one of the elements recited in Claims 7 to 10, should the Examiner maintain the § 102 rejection of Claims 7 to 10 over DoubleClick.

Furthermore and with respect to claim 2, a modified single integrated ad file having a single file extension is created by combining, at a server, a received modified ad input file representing a change to the content of an ad with the conduit file; claim 3 recites receiving a modified conduit file representing a change to the tracking data, combining the modified conduit file with the ad input file to create a modified single integrated ad file having a single file extension, and serving the modified single integrated ad file from the server, to provide an ad having the changed tracking data. DoubleClick seems to provide the designer with instructions for making <u>the FLASH file</u> compliant with DoubleClick. The instructions require that <u>the FLASH file</u> include a "clickTag" parameter/variable with appropriate settings. According to DoubleClick, the designer would need to follow the instructions provided in DoubleClick on

how to make the FLASH file compliant, i.e., include the "clickTag" variable and settings per the instructions provided in DoubleClick. DoubleClick does not disclose or suggest combining a modified ad input file with a conduit file to create a modified single integrated ad file. Further, DoubleClick does not teach or suggest combining a modified conduit file with an ad input file to create a modified single integrated ad file. As a result, dependent Claims 2 and 3 are allowable over DoubleClick. Similar reasoning is also applicable to claims 13, 14, 22, 23 and 28.

Referring to Claim 5, the ad input file includes an empty movie clip object such that the combining of an ad input file with a conduit file to create a single integrated ad file recited in claim 1 includes inserting the conduit file into the empty movie clip object. Claim 6 depends from claim 5, and further recites that the empty movie clip object is given a predefined name and combining the ad input file and conduit file includes searching the ad input file for the predefined name and inserting the conduit file into the empty movie clip with the predefined name. The Examiner concedes, at page 5, that DoubleClick fails to *teach placeholders for the files*.

At page 5 of the Office Action, the Examiner states that Chun *teaches that Flash includes empty placeholders and also teaches that placeholder means the end of the movie, and that there is no more frames available to display*. Even if Chun teaches an empty placeholder, and that a placeholder *means the end of the movie* and *that there are no more frames available*, as suggested by the Examiner, this would not disclose the claimed empty movie clip object of the ad input file into which the claimed conduit file is inserted, combining an ad input file and a conduit file by inserting the conduit file into the empty movie clip of the ad input file, searching the ad input file for a predefined name of the empty movie clip of the ad input file, and combining an ad input file to create an integrated ad file by inserting the conduit file into the empty movie clip having the predefined name in the ad input file, as recited in claims 5 and 6. For at least the same reasons, the combination of DoubleClick and Chun is also deficient with respect to claims 15-21.

Since DoubleClick is missing at least one, and in many cases more than one, element of the claims, DoubleClick cannot properly be used as the basis for a § 102 rejection. Furthermore, and since DoubleClick is missing at least one element which is also not disclosed in Chun relied upon by the Examiner or the Official Notice taken by the Examiner, DoubleClick in view of the

Official Notice taken, or DoubleClick in view of Chun, cannot form the basis of a proper

§ 103(a) rejection of the claims.

In view of the foregoing, the entire application is believed to be in condition for

allowance, and such action is respectfully requested at the Examiner's earliest convenience.

Should matters remain which the Examiner believes could be resolved in a telephone

interview, the Examiner is requested to telephone the Applicant's undersigned attorney.

Alternatively, since it is believed that the claims of the present application are in condition for

allowance, the Examiner is respectfully requested to issue a Notice of Allowance at the

Examiner's earliest convenience.

The Applicant's attorney may be reached by telephone at 212-801-6729. All

correspondence should continue to be directed to the address given below, which is the address

that is associated with Customer Number 76058.

The Commissioner is hereby authorized to charge any required fee in connection with the

submission of this paper, any additional fees which may be required, now or in the future, or

credit any overpayment to Account No. 50-1561. Please ensure that the Attorney Docket

Number is referenced when charging any payments or credits for this case.

<div align="center">Respectfully submitted,</div>

Date: August 31, 2010   /jjdecarlo/
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